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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,274	03/09/2000	Regis Nicolas	PALM-3024.IPG.US.P	2735

7590 10/08/2003
Wagner Murabito & Hao LLP
Two North Market Street
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San Jose, CA 95113

EXAMINER

SAID, MANSOUR M

ART UNIT	PAPER NUMBER
2673	14

DATE MAILED: 10/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/522,274

Applicant(s)

NICOLAS ET AL.

Examiner

MANSOUR M SAID

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-11 and 13-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-11 and 13-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This office action is in respond to the RCE and amendment filed on July 16, 2003.
2. Applicant's arguments with respect to claims 1, 3-11, and 13-24 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1, 4-5, 7, 10, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida (5,067,573) in view of Schrock et al. (5,845,161; hereinafter referred to as Schrock).**

As to claims 1, Uchida teaches a computer system (electronic notebook tablet, (figures 1-2, (1)) comprising a processor coupled to bus and a memory unit (figure 1, (13-14)), and (column 3, lines 29-34), coupled to the bus; a display screen (liquid crystal tablet panel, (figures 1-2, (13)) coupled to the bus (since the processor, memory & display coupled to bus is well known to computer system, so that, Uchida's electronic notebook tablet, (figures 1-2, (1)) understood to include the claimed limitation (column 3, lines 29-34); a case (case, (figures 1-2,

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(2)) for supporting the processor (column 2, lines 31-67, the memory unit (column 2, lines 31-67), and the display screen (liquid crystal tablet panel, (Uchia's device considered as a computer hand-held having a processor, and memory), (figures 1-2, (13)) (column 2, lines 31-67 and column 3, lines 29-34) the case (case, (figures 1-2, (2)) having a slot (pen receptacle, (figures 1-2, (23)) comprising an opening at one end of the slot (pen receptacle, (figures 1-2, (23))for receiving for detecting the stylus in the slot (column 59-67), a switch coupled to the detector for generating a signal to power up the processor (abstract; column 3, lines 1-28, column 5, lines 38-67, and column, lines 53-56),the display screen (liquid crystal tablet panel, (figures 1-2, (13)) into a power conservation mode when the stylus (pen, (figures 1-3, (14)) is inserted into the slot (pen receptacle, (figures 1-2, (23)) (figures 1-3; abstract; column 3, lines 1-28; column 4, lines 40-67 and column 5, lines 38-67).

Uchida does not expressly disclose a digital system.

However, Schrock teaches a stylus (figure 1 (14))) comprising a touch screen having a digital system (column 2, lines 15-24; column 2, lines 66-67, column 3, lines 1-9).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to combine Schrock's teaching detecting the stylus into Uchida's modified system so to effect a mode change (column 2, lines 10-11).

As to claim 4, Uchida teaches the detector is located within the slot (pen receptacle, (figures 1-2, (23)) and is an electrical detector (detector associated with receptacle, (23), (column 1, lines 49-56).

As to claim 5, Uchida teaches the computer system is a palmtop computer system (hand-writing input apparatus, (figures 1-3)) (abstract and column 2, lines 31-67).

As to claim 7, Uchida teaches all claimed limitation but omit a digital system.

However, Schrock teaches a stylus (figure 1 (14))) comprising a touch screen having a digital system (column 2, lines 15-24; column 2, lines 66-67, column 3, lines 1-9).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to combine Schrock's teaching detecting the stylus into Uchida's modified system so to effect a mode change (column 2, lines 10-11).

As to claim 10, Uchida teaches a computer system (electronic notebook tablet, (figures 1-2, (1)) comprising a processor coupled to bus and a memory unit (figure 1, (13-14)), and (column 3, lines 29-34), coupled to the bus; a display screen (liquid crystal tablet panel, (figures 1-2, (13)) coupled to the bus (since the processor, memory & display coupled to bus is well known to computer system, so that, Uchida's electronic notebook tablet, (figures 1-2, (1)) understood to include the claimed limitation (column 3, lines 29-34); a case (case, (figures 1-2, (2)) for supporting the processor (column 2, lines 31-67, the memory unit (column 2, lines 31-67), and the display screen (liquid crystal tablet panel, (Uchia's device considered as a computer hand-held having a processor, and memory), (figures 1-2, (13)) (column 2, lines 31-67 and column 3, lines 29-34) the case (case, (figures 1-2, (2)) having a slot (pen receptacle, (figures 1-2, (23)) comprising an opening at one end of the slot (pen receptacle, (figures 1-2, (23))for receiving for detecting the stylus in the slot (column 59-67), a switch coupled to the detector for generating a signal to power up the processor (abstract; column 3, lines 1-28, column 5, lines 38-67, and column, lines 53-56),the display screen (liquid crystal tablet panel, (figures 1-2, (13)) into a power conservation mode when the stylus (pen, (figures 1-3, (14)) is inserted into the slot (pen receptacle, (figures 1-2, (23)) (figures 1-3; abstract; column 3, lines 1-28; column 4, lines

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40-67 and column 5, lines 38-67), in response to the detecting non-mechanically a user inserting the stylus (column 1, lines 49-56) and a computer system is powered-up, powering-down processor, the display screen when on/off button is pressed (column 3, lines 1-28, and column 5, lines 39-67).

Uchida does not expressly disclose a digital system.

However, Schrock teaches a stylus (figure 1 (14))) comprising a touch screen having a digital system (column 2, lines 15-24; column 2, lines 66-67, column 3, lines 1-9).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to combine Schrock's teaching detecting the stylus into Uchida's modified system so to effect a mode change (column 2, lines 10-11).

As to claim 17, Uchida teaches all claimed limitation including a computer system is powered-up, powering-down processor, the display screen when on/off button is pressed (column 3, lines 1-28, and column 5, lines 39-67).

Uchida does not expressly disclose a digital system.

However, Schrock teaches a stylus (figure 1 (14))) comprising a touch screen having a digital system (column 2, lines 15-24; column 2, lines 66-67, column 3, lines 1-9).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to combine Schrock's teaching detecting the stylus into Uchida's modified system so to effect a mode change (column 2, lines 10-11).

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4. Claims 3, 6, 11, and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida in view of Schrock as applied to claims 1 and 10 above, and further in view of Ogawa (6,100,538).

As to claims 3, 6, 11, 13, and 16, Uchida and Schrock teach all claimed limitation except that optical detector and a battery, which is supplying power to the computer.

However, Ogawa (figures 1-2) teaches an optical digitizer and display panel (6), a stylus (2) for an inputting device or pointer. Stylus that projects light directly or indirectly on a coordinate plane (1), the digitizer is provided with detector means units (3L and 3R) arranged around the coordinate plane (1) (column 6, lines 40-67), and also optical detector and a battery which is supplying power to the computer (abstract; column 2, lines 40-67; column 3, lines 40-56; column 4, lines 1-10; column 5, lines 19-30; column 9, lines 22-50; column 12, lines 30-62; and column 13, lines 1-25).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to combine Ogawa's optical digitizer device having optical detector and battery into Uchida's modified device so as to provide an optical digitizer capable of operating with stability with out being affected by extraneous light including light radiated from the display panel of the digitizer (column 2, lines 40-46).

As to claim 14, Uchida teaches the detector is located within the slot (pen receptacle, (figures 1-2, (23))) and is an electrical detector (detector associated with receptacle, (23), (column 1, lines 49-56).

As to claim 15, Uchida teaches the computer system is a palmtop computer system (hand-writing input apparatus, (figures 1-3)) (abstract and column 2, lines 31-67).

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida in view of Schrock as applied to claims 1 above, and further in view of Dao et al. (5,049,862; hereinafter referred to Dao).

As to claim 8, Uchida and Schrock disclose all claimed limitations except that a first region for capturing stroke data associated with alphabetic characters and a second region for capturing stroke data associated with numeric characters.

However, Dao teaches (figure 1) a notebook (10) includes a first panel, a second panel (14) connected to first panel (12) by a hinge means (16) that allows both first and second panel to orient in a multitude of angles about hinge means, and a stylus (18) for writing on first panel and second panel. First panel (12) has flat surface (20) with an opaque first digitizer tablet (22) and allows placement of standard templates (column 3, line 60 through column 4, line 14); and a first region for capturing stroke data associated with alphabetic characters and a second region for capturing stroke data associated with numeric characters (figure 8, column 7, line 42 through column 8, line 3).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to combine Dao's portable computer having alphabetic and numeric character into Uchida's modified device to allow real-time coupling of manual paper form completion into machine recognizable form (column 1, lines 1-10).

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida in view of Schrock as applied to claim above, and further in view of Snell (5,756,941).

Uchida and Schrock disclose all claimed limitation but omit that the digitizer is separate in area from the display.

However, Snell the digitizer is separate in area from the display (column 3, lines 50-67).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to have Snell's teaching into Uchida's modified system so as to increase the versatility of the device.

7. Claims 8-21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida (5,067,573) in view of Schrock et al. (5,845,161; hereinafter referred to as Schrock).

As to claims 18-19 and 23, Uchida teaches a computer system (electronic notebook tablet, (figures 1-2, (1)) comprising a processor coupled to bus and a memory unit (figure 1, (13-14)), and (column 3, lines 29-34), coupled to the bus; a display screen (liquid crystal tablet panel, (figures 1-2, (13)) coupled to the bus (since the processor, memory & display coupled to bus is well known to computer system, so that, Uchida's electronic notebook tablet, (figures 1-2, (1)) understood to include the claimed limitation (column 3, lines 29-34); a case (case, (figures 1-2, (2)) for supporting the processor (column 2, lines 31-67, the memory unit (column 2, lines 31-67), and the display screen (liquid crystal tablet panel, (Uchia's device considered as a computer hand-held having a processor, and memory), (figures 1-2, (13)) (column 2, lines 31-67 and column 3, lines 29-34) the case (case, (figures 1-2, (2)) having a slot (pen receptacle, (figures 1-2, (23)) comprising an opening at one end of the slot (pen receptacle, (figures 1-2, (23))for receiving for detecting the stylus in the slot (column 59-67), a switch coupled to the detector for generating a signal to power up the processor (abstract; column 3, lines 1-28, column 5, lines 38-

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67, and column, lines 53-56), the display screen (liquid crystal tablet panel, (figures 1-2, (13)) into a power conservation mode when the stylus (pen, (figures 1-3, (14)) is inserted into the slot (pen receptacle, (figures 1-2, (23)) also teaches a hinge (figures 1-3; abstract; column 3, lines 1-28; column 4, lines 40-67 and column 5, lines 38-67) .

Uchida does not expressly disclose a digital system.

However, Schrock teaches a stylus (figure 1 (14))) comprising a touch screen having a digital system (column 2, lines 15-24; column 2, lines 66-67, column 3, lines 1-9).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to combine Schrock's teaching detecting the stylus into Uchida's modified system so to effect a mode change (column 2, lines 10-11).

As to **claim 20**, Uchida teaches wherein the detector is located within the slot and is an electrical detector (detector associated with receptacle, (23), (column 1, lines 49-56).

As to **claim 21**, Uchida (figures 2a-2c) teaches wherein the computer system is a palmtop computer system (figures 1-3)) (abstract and column 2, lines 31-67).

8. Claims 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida in view of Schrock as applied to claim 18 above, and further in view of Ogawa (6,100,538).

Uchida and Schrock teach all claimed limitations in claim 22 except that optical detector and a battery, which is supplying power to the computer.

However, Ogawa (figures 1-2) teaches an optical digitizer and display panel (6), a stylus (2) for an inputting device or pointer. Stylus that projects light directly or indirectly on a coordinate plane (1), the digitizer is provided with detector means units (3L and 3R) arranged

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around the coordinate plane (1) (column 6, lines 40-67), and also optical detector and a battery which is supplying power to the computer (abstract; column 2, lines 40-67; column 3, lines 40-56; column 4, lines 1-10; column 5, lines 19-30; column 9, lines 22-50; column 12, lines 30-62; and column 13, lines 1-25).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to combine Ogawa's optical digitizer device having optical detector and battery into Uchida's modified device so as to provide an optical digitizer capable of operating with stability without being affected by extraneous light including light radiated from the display panel of the digitizer (column 2, lines 40-46).

9. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida in view of Schrock as applied to claim 18 above, and further in view of Dao et al. (5,049,862; hereinafter referred to as Dao).

Uchida and Schrock disclose all claimed limitations in claim 8 except that a first region for capturing stroke data associated with alphabetic characters and a second region for capturing stroke data associated with numeric characters.

However, Dao teaches (figure 1) a notebook (10) includes a first panel, a second panel (14) connected to first panel (12) by a hinge means (16) that allows both first and second panel to orient in a multitude of angles about hinge means, and a stylus (18) for writing on first panel and second panel. First panel (12) has flat surface (20) with an opaque first digitizer tablet (22) and allows placement of standard templates (column 3, line 60 through column 4, line 14).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to have Dao's teaching into Uchida' modified system so as to increase the versatility of the display device.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to **Mansour M. Said** whose telephone number is **(703) 306-5411**.

The examiner can normally be reached on Monday through Thursday from 8:30 a.m. to 6:00 p.m. The examiner can also be reached on alternate Friday from 8:30 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Shalwala Bipin**, can be reached at **(703) 305-4938**

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist)

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer service Office

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Whose telephone number is (703) 306-0377.

Patent Examiner

October 2, 2003

Mansour M. Said



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TECHNOLOGY CENTER 2600